



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,405	03/10/2000	Lance Johnson	049640-0002	4642
7590	04/20/2004		EXAMINER	
Joseph Yang Skadden Arps Slate Meagher & Flom LLP 525 University Avenue Suite 1100 Palo Alto, CA 94301			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/523,405	JOHNSON ET AL
	Examiner	Art Unit
	JAGDISH PATEL	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 December 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-49 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-49 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This communication is in response to amendment filed 12/18/03.

Response to Amendment/Remarks

2. In response to the applicant's response and remarks therein, rejection of claims 1-49 have been withdrawn. In view of the new grounds of rejection presented in this office action the Applicant's arguments with respect to claims 1-23 have been rendered moot.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites step (b) obtaining from said customer information identifying at least two payment instruments. Then step (b) further recites limitation (i)-(iii) which do not functionally relate to the obtaining step. For example limitation (i) said customer is willing to allow said payment instrument to be processed using any of the identified payment instruments does not affect the claimed invention as the claim only recites the process of obtaining the information that identifies the instruments.

Step (c) recites submitting information regarding said identified payment instruments to a computer-implemented transaction evaluator configured to automatically select one said identified payment instruments.... However, the claim fails to recite that actual selection of the payment instruments occurs as per the configuration of the transaction evaluator..

This also renders steps (d) – (f) indefinite since they require that actual selection of payment instruments takes place.

Claims 5 and 6 recite ..obtaining ..explicit authorization... this limitation does not relate to any another limitation (process step) of claim 1. Note that the receiving funds for the payment are performed regardless of the notifying step.

Claim 15 recites selection of one of identified payment instruments issued by the winner of the electronic auction among the issuers of the identified payment instruments. However, this selection has clear relationship to the method of charging payment transaction recited in claim 1.

Similar analysis is also applied to apparatus claim 41.

Claim 16-18 recite updating records containing payment instrument selection criteria. However, this process has no relationship to functionality of steps (a) – (f) of claim 1 rendering the claims indefinite.

Claims 22-25 are also rendered indefinite for the similar reason. (limitation has no relationship to functionality of steps (a) – (f) of claim 1).

Similar deficiencies also render claims 28, 29, 31, 41, 47 indefinite.

Apparatus claim 35 is rendered indefinite for the reasons discussed for method claim 1. For example limitation (i) – (iii) have no relationship to means for obtaining information. The apparatus furthermore, fails to recite means for automatic selection of the identified payment instruments which is required for elements (d) and (e).

Note that dependent claims inherit deficiencies of their parent claims.

For these reasons the apparatus claims 39-49 are also rendered indefinite.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7-9, 26, 32-37, 48 rejected under 35 U.S.C. 102(e) as being anticipated by Bahreman.

Per claim 1, Bahreman discloses a method for charging a payment transaction to a customer, comprising the steps of:

- (a) soliciting from said customer a plurality of payment transactions (col. 12 L 61- 65 preference information entered by clients);
- (b) obtaining from the customer at least two payment instruments, where:
 - (i) said customer is willing to allow said payment transaction to be processed using any of .. payment instruments,
 - (ii) said identified instruments use different funding sources
 - (iii) where each of said payment instruments is usable for processing said payment transaction in its entirety;
(payment capabilities , see col. 14 L 64 – col. 15 L 1);
- (c) submitting information regarding said payment instruments to a computer-implemented transaction evaluator to automatically select one of the identified payment instruments based on the relative utility of the identified payment instruments;
(refer to function of “payment negotiation manager” as per col. 14);
- (d) receiving from said transaction evaluator a selection of one of said identified payment instruments;
(col. 12 L 49-60, the decision include..payment account ..acceptable to both parties);
- (e) notifying said customer which of the identified payment instruments was selected (col. 15, L 4+ .. The results are aggregated and added in the result payment capability list. Depending upon the status specified in the input request message, i.e. Payment required at this Stage, Payment Processing Methods specification options at this stage etc., single or multiple payment mechanisms are presented.);
- (f) receiving funds for payment of said transaction using said selected payment instrument;
(Col. 12 L 42+ The result of the exchange of messages is an agreement on a particular payment processing method that is utilized for a particular transaction or a series of transactions.)

Art Unit: 3624

Claim 2: ..relative economic utility is that to a merchant performing at least step (a) (abstract .. The weight is provided by both the client and the merchant to facilitate dynamic negotiation of a mutually acceptable payment processing. The negotiation results in the exchange of standard message formats that the client and the merchant are equipped to process efficiently and securely.).

Claim 3: additional step prior to step (f) of electronically transmitting to a payment network data identifying at least said selected payment instrument and the amount of said transaction (col. 12 L 49 + There are several decisions to be made by the applications during a transaction before the actual payment process begins. The decisions include determining a payment processing method, payment capability, payment protocol, payment account and a payment instrument that is acceptable to both parties.).

Claim 4: receiving confirmation from said payment network that said payment transaction was processed successfully (col. 15 L 9-12 Status codes are shown to the user, indicating the process flow, error/recovery etc.).

Claim 7: steps (a), (b) and (c) are performed via electronic communication ..(see Fig. 1 and 2 which depict the communication network arrangement).

Claim 8: electronic communication includes automated telephony based response system (see col. 11 L 55 "The connection could be by means of the Internet, a dialup link, token ring, cellular phone, satellite, T1 or X.25 Telco link or other communication means.").

Claim 9: at least step (a) includes sending a form over the Internet to a web browser operated by said customer (col. 11 L 45+ The computer has resident thereon and is controlled and coordinated by operating system software such as the SUN Solaris, Windows NT or Java's operating system.).

Claim 26. refer to claim 1 analysis.

Claims 32, 33, 34, 48 and 49: recited limitations, payment instrument types and computer-based accounting system are inherent because the cited reference pertains to electronic purchase transaction involving different types of credit cards.

Claim 35 is analyzed as per corresponding method claim 1.

Claims 36 and 37 are analyzed as per corresponding method claims 8 and 9.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahreman as applied to claim 1 and further in view of Ronen (US Pat. 5,845,267) (Ronen).

Claim 27: Bahreman fails to teach, however, Ronen teaches the step of obtaining transaction authorization as recited (Ronen col. 8 L 10-15, ..the user has not exceeded any credit limit..If the user is authorized to proceed).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the step of obtaining transaction authorization as recited per Ronen in Bahreman because it would ensure that the transaction is legitimate and the user has sufficient credit for the transaction.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

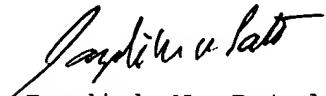
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official

Application/Control Number: 09/523,405
Art Unit: 3624

Page 7

faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.


Jagdish N. Patel

(Primary Examiner, AU 3624)

4/19/04